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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dean Hahn-Carlson

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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN HAHN-CARLSON

Application 09/527,717
Technology Center 3600

Mailed: January 26, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on September 22, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

ANSWER, STATUS OF AMENDMENTS

A review of the file finds that the status of the amendments as provided in the Examiner's Answer mailed January 10, 2008 under the heading "Status of Amendments" is unclear and/or is not consistent with the last **entered** amendment of record in accordance with 37 CFR 41.37(c)(1)(iv).

An After Final Amendment was filed on May 14, 2007. An Advisory Action was mailed on June 5, 2007 but did not notify Appellant regarding the entry status of the After Final Amendment. In addition, the Examiner has not provided the necessary statement as to the status of the After Final Amendment filed May 14, 2007. Correction of the status of amendment(s) filed subsequent to Final rejection is required.

EXAMINER'S ANSWER, STATUS OF CLAIM

A review of the file indicates a Request for Restriction/Election was mailed on May 22, 2006 which stated:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 13, 16-27, drawn to merchant offering, validating a service for auditing, classified in claim 705, subclass 75.
- II. Claims 14 and 15, drawn to billing a vendor, classified in class 705, subclass 34.

The response to Restriction Requirement filed June 12, 2006 stated:

In response to the non-final Office Action dated May 22, 2006, in which a restriction requirement was made, the claims of Group I (13 and 16-27) are hereby elected, with traverse.

The Non-Final Rejection mailed September 12, 2006 and the Final Rejection mailed March 15, 2007 state that “[c]laims 13 and 16-26 is/are pending in the application” and that “[c]laims 13 and 16-26 is/are rejected.” It should be noted that claim 27 is not discussed in either of these rejections. A Notice of Appeal was filed on July 16, 2007 which stated that “[p]resented for appeal are claims 13-27.” Page 5 of the Appeal Brief filed October 15, 2007, lists the “Grounds of Rejection and another Issue to be Reviewed Upon Appeal” as follows:

- A. Claims 13 and 16-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Henn (U.S. Patent No. 5,770,844).
- B. Claim 27 should be deemed allowable because the Office Actions of record are silent as to this claim and fail to state any rejection thereof.

It is noted that the Examiner’s Answer mailed January 10, 2008 also fails to discuss the status of claim 27. Clarification is required.

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to vacate the Examiner’s Answer mailed January 10, 2008;

- 2) to generate a new Examiner's Answer setting forth the correct status of the after final amendment(s) and to correct other sections of the Answer as may be required;
- 3) to clarify the status of claim 27; and
- 4) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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